



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,558	10/03/2003	Thumplasseril V. John	IFF-63	2540
48/80	7590	06/18/2009		
INTERNATIONAL FLAVORS & FRAGRANCES INC. 521 WEST 57TH ST NEW YORK, NY 10019				
EXAMINER				
CHEN, CATHERYNE				
ART UNIT		PAPER NUMBER		
1655				
MAIL DATE		DELIVERY MODE		
06/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/678,558

**Applicant(s)**

JOHN ET AL.

**Examiner**

CATHERYNE CHEN

**Art Unit**

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 4, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-4, 40-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Currently, Claims 3-4, 40-41 are pending. Claims 3-4, 40-41 are examined on the merits. Claims 1-2, 5-39, 42-50 are canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2009 has been entered.

The declaration of Thumplasseril V. John, PhD. filed May 15, 2009 has been considered.

### ***Election/Restrictions***

Applicant's election without traverse of the species tingling sensate, spilanthol, in the reply filed on Feb. 6, 2008 is acknowledged.

### ***Response to Arguments***

The declaration of Thumplasseril V. John, PhD. has been considered; however, it does not overcome the rejections. As evident in Applicant's Specification, the mixtures of alkadienamides are extractions from one of the Piper species (page 3, paragraph 4).

Black pepper extract is one of the Piper species; therefore, the mixtures of alkadienamides would contain the claimed mixture.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-4, 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakatsu et al. (US 6780443 B1) for the reasons set forth in the previous Office Action, which is set forth below. All of Applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive.

Nakatsu et al. teaches from about 0.001% by weight to about 10% by weight of a tingling sensate substance (column 10, lines 9-12) of spilanthol, Saanshool-I, Saanshool-II and Sanshoamide, Black pepper extract, which inherently contain alkadienamides (column 3, lines 7-12).

Applicant argues that the reference includes other ingredients.

In response to Applicant's argument, the language of the claim is "comprising," thus other ingredients are not excluded.

Applicant argues that black pepper extract would not contain the alkadienamides claimed.

In response to Applicant's argument that black pepper extract from Piper nigrum does not contain the claimed alkadienamides, the Specification on page 3, last

paragraph indicated that the alkadienamides can be extracted from Piper species. Black pepper or Piper nigrum is a species of Piper; thus, black piper would inherently contain a mixture of the claimed alkadienamides.

Applicant argues that tingling sensate of spilanthol is not taught.

In response to Applicant's argument, spilanthol is taught (Abstract and column 3, line 12).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-4, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu et al. (US 6780443 B1) for the reasons set forth in the previous Office Action, which is set forth below. All of Applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive.

Nakatsu et al. teaches from about 0.001% by weight to about 10% by weight of a tingling sensate substance (column 10, lines 9-12) of spilanthol, Saanshool-I, Saanshool-II and Sanshoamide, Black pepper extract (column 3, lines 7-11), which intrinsically contain alkadienamides of N-isobutyl-E2, E4, decadienamide, N-isobutyl-E2, E4-undecadienamide, N-pyrrolidyl-E2, E4-decadienamide, N-piperidyl-E2, E4-decadienamide (see Applicant's Specification, page 3, last paragraph). However, it does not teach all of the claimed concentrations.

The reference also does not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

Applicant argues that tingling sensate of spilanthol is not taught.

In response to Applicant's argument, spilanthol is taught (Abstract and column 3, line 12).

Applicant argues that black pepper extract from *Piper nigrum* does not contain the claimed alkadienamides.

In response to Applicant's argument that black pepper extract from *Piper nigrum* does not contain the claimed alkadienamides, the Specification on page 3, last paragraph indicated that the alkadienamides can be extracted from *Piper* species. Black pepper or *Piper nigrum* is a species of *Piper*; thus, black piper would inherently contain a mixture of the claimed alkadienamides.

***Conclusion***

No claim is allowed.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catheryne Chen whose telephone number is 571-272-9947. The examiner can normally be reached on Monday to Friday, 9-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Catheryne Chen  
Examiner Art Unit 1655

Application/Control Number: 10/678,558  
Art Unit: 1655

Page 7

/Michael V. Meller/

Primary Examiner, Art Unit 1655